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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,801	10/30/2001	Stephen Edward Rees	0459-0683P	7859
2292	7590	10/14/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/890,801	REES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 and 51-56 is/are allowed.
- 6) ☒ Claim(s) 30,33,34,37-39,41,43-50 and 57-59 is/are rejected.
- 7) ☒ Claim(s) 31,32,35,36,40 and 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The final rejection is being withdrawn and this action entered to address a problem with claims 49 and 50 discovered during discussions after final with applicant.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both of these claims recite computer programs adapted to determine parameters according to claim 1. However, claim 1 does not recite any method steps, it is an apparatus claim. Accordingly, it is unclear exactly what the scope of these claims is, as it is unclear how it determines the parameters.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

7(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 33, 34, 37-39, 41, 43-48, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. Shaffer et al shows a system that has a gas blender that mixes gas from two sources, an oxygen saturation measuring device (first detection means) that measures oxygen saturation and, if it deviates from a target level, adjust the fraction of inspired oxygen, which is measured with the processor (second detection means), to increase the oxygen saturation. In addition, in column 23, lines 13-20, Shaffer discloses that the device calculates the FiO<sub>2</sub> (fraction of oxygen

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in the mixture) necessary to achieve a target oxygen saturation. Claims 37-39 are rejected in that two respiratory parameters are determined based on two measurements (one each). With respect to claims 45-48, the device is useable on a person with COPD or to screen for COPD.

Claims 1-29 and 51-56 are allowable.

Claims 1-14 and 51-56 define over the art in that none of the art determines respiratory parameters, as defined in the specification, based on two concurrent measurements of inspiratory or expiratory oxygen levels and blood oxygen levels, as claimed. Claims 15-29 define over the art in that none of the art has the computer adapted to determine if more measurements are required. In both sets of claims (10-14 and 15-29), the claims recite that the computer is adapted to make certain calculations. The examiner is interpreting the term "adapted" to mean programmed to make the calculations, as opposed to being capable of making the calculations.

Claims 31, 32, 35, 36, 40, and 42 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Claims 35, and 36 define over the art if record in that none of the art shows the recited third and fourth detection means. Claims 40 defines over the art in that none of the art calculates the oxygen consumption, as claimed. Claims 31, and 32 define over the art in that none of the art shows the methods of assessing the change in oxygen levels. Claims 42 defines over the art in that none of the art teaches using a gas with an oxygen level in the range claimed.

Applicant's arguments filed 2/6/2004 have been fully considered but they are not persuasive.

With respect to claim 30, applicant has stated that the device of Shaffer does not calculate the change needed in the FiO2 level to produce the target oxygenation level. However, the claim only recites that the device assess the change needed. Shaffer does indeed assess whether a change is needed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
October 13, 2004



ROBERT L. NASSER  
PRIMARY EXAMINER